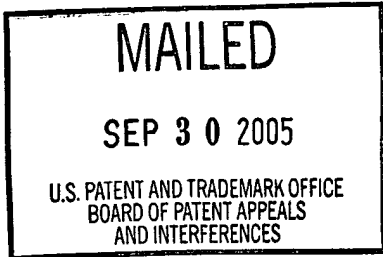


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARTMUT RICHTER and DIETMAR UHDE

Appeal No. 2005-2451
Application No. 09/575,080

ON BRIEF

Before THOMAS, RUGGIERO, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 2, 6, 8, and 9. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 4, 5, and 7 are allowed.

We affirm-in-part.

BACKGROUND

Appellants' invention relates to an optical recording medium having a plurality of semi-transparent information carrier layers, wherein each layer is readable from either side of the

recording medium but writable from only one side. An understanding of the invention can be derived from a reading of exemplary independent Claim 1, which is reproduced as follows:

1. Optical recording medium comprising at least two information carrier layers, on which information can be written by means of a focused light beam, a separating layer arranged between said information carrier layers, and a transparent covering layer, which is arranged between said information carrier layer and a surface of the recording medium and whose thickness substantially exceeds that of said information carrier layer, wherein each information carrier layer is semi-transparent.

The Examiner relies on the following prior art reference:

Kobayashi et al. (Kobayashi) 5,703,868 Dec. 30, 1997

Claims 1, 2, 6, 8, and 9 stand rejected under 35 U.S.C.
§ 102(b) as being anticipated by Kobayashi.

Rather than reiterate the opposing arguments, reference is made to the brief and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

Regarding claim 1, Appellants argue (brief, page 5) that Kobayashi does not disclose an optical recording medium including at least two semi-transparent information carrier layers.

Rather, Appellants argue that Kobayashi discloses "first and second recording faces of first and second substrates [that] are covered with semi-transparent layers." We do not find this persuasive because the difference between Appellants' claim language and Kobayashi's Figure 3 description is one of semantics. Kobayashi discloses in Figure 3 an optical recording medium comprising a first substrate (22), a first information recording face (23), and a first semi-transparent layer (24). Information is written to the semi-transparent layer (24) because that is the layer that, due to its absorptive properties, is capable of retaining information. Thus, the information recording face (23) is actually the boundary interface between the substrate (22) and the semi-transparent layer (24). Therefore, Kobayashi does disclose an information carrier layer that is semi-transparent. Similarly, the second information carrier layer (31) is a semi-transparent layer and retains information. Accordingly, the rejection on Claim 1 is sustained.

Regarding Claim 2, Appellants argue (brief, page 6) that Kobayashi does not disclose an optical recording medium including at least two semi-transparent information carrier layers wherein each layer can be read from both sides but can be written to from only one side. We find this persuasive because there is no teaching in Kobayashi that each information carrier layer is

capable of being read from both sides of the recording medium. Kobayashi discloses (column 9, lines 42-52) that "either the recording medium can be reversed to change the reproduction face or the optical pickup may be designed so that it can irradiate with the laser beam from upper and lower sides," which indicates that each information carrier layer can only be written to from one side. Although Kobayashi does not explicitly use the term "reading" with respect to Figure 3, this same passage (column 9, lines 42-52) discloses reading each layer from one side via the optical pickup element. The Examiner does not identify, nor do we find, any teaching that would indicate that each information carrier layer is readable from both sides. Accordingly, the rejection on Claim 2 cannot be sustained.

With respect to Claim 6, Appellants argue (brief, page 6) that Kobayashi does not disclose an optical recording medium including at least two semi-transparent information carrier layers separated by a separating layer where the separating layer has at least one further information carrier layer. The Examiner, however, argues (answer, page 6) that Kobayashi discloses in Figure 3 separation layer(s) (25 or 32) and at least one further information carrier layer (26(27) or 33(34)). We agree with the Examiner's position because although he initially referred to layers 25 or 32 as the separating layer, any layer

physically located between the two information carrier layers

(24, 31) could be considered a "separating layer."

Alternatively, all the layers between the two information carrier layers (24, 31) could collectively be considered a single

"separating layer." Either way, Kobayashi does disclose a separating layer (26 or 33) between the two information carrier layers (24, 31) that is also an information carrier layer.

Accordingly, the rejection on Claim 6 is sustained.

Regarding Claim 8, Appellants argue (brief, page 7) that Kobayashi does not disclose an optical recording medium including at least two semi-transparent information carrier layers that are write-once layers. The Examiner argues (answer, page 6) that Kobayashi discloses (column 2, lines 3-5) a DVD that is "designed as a double-sided reproducible optical information recording medium." The Examiner then states that "it is considered at least inherent to this medium that it would not be capable of being recorded on subsequent to the initial recording" (id.). As information carrier layers are known to be either permanent or re-writeable and based on the reference teachings and the two available options, the artisan may choose from write-once or re-writable recording mediums depending on whether the data should be stored permanently or be written over. As such, while Kobayashi does not explicitly identify the DVD as a write-once

optical recording medium, as held in In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), we find that a person of ordinary skill in the art would understand the benefit of write-once type when permanency of recording is desired. See also Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1347, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000) (even if a piece of prior art does not expressly disclose a limitation, it anticipates if a person of ordinary skill in the art would understand the prior art to disclose the limitation and could combine the prior art description with his own knowledge to make the claimed invention). Thus, a skilled artisan could take Kobayashi's teachings in combination with his own knowledge and be in possession of the recording medium of Appellants' claim 8. Accordingly, we sustain the rejection of Claim 8.

Regarding Claim 9, Appellants argue (brief, page 8) that Kobayashi does not disclose an optical recording medium including at least two semi-transparent information carrier layers that have preformatted tracks wherein the rotational sense of each track viewed from the same side is unidirectional and opposed. Kobayashi discloses (column 6, lines 55-58) that the information carrier layers may be formed with recesses (i.e. pits) that may be written in either spiral or concentric circle form, which indicates preformatted tracks. If the preformatted tracks,

however, are written in concentric circles, there is no rotational or directional sense. Thus, the claim 9 analysis is from the standpoint that the preformatted tracks are written in spirals from the center of the disc outwards.

The Examiner correctly states (answer, page 7) that Kobayashi discloses (column 6, lines 55-58) preformatted tracks having a unidirectional rotational sense. This feature is depicted in Figure 3 wherein the information carrier layers (24, 31) are formed with recesses (i.e. pits) that may be recorded from the center of the disc outwards in a spiral form. Figure 3 also shows that the cross-sectional patterns of each preformatted track within the respective information carrier layer (24, 31) are identical. However, given that the preformatted tracks are written from the center outwards, they must have the same directional sense (i.e. clockwise or counter-clockwise) so that the cross-sectional patterns of the tracks would be similar. Thus, as argued by Appellants, nothing in Kobayashi indicates that the preformatted tracks have an opposed rotational sense. Accordingly, the rejection on Claim 9 is not sustained.

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CONCLUSION

In view of the forgoing, the decision of the Examiner rejecting claims 1, 6 and 8 under 35 U.S.C. § 102 is affirmed, but reversed with respect to rejecting claims 2 and 9 under 35 U.S.C. § 102.


No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JAMES D. THOMAS
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

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MAHSHID D. SAADAT
Administrative Patent Judge

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